# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/713,180 | 11/13/2003 | Hidetada Nago | 1232-5208 | 9816 |

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| EXAMINER |
|---|
| HOLLIDAY, JAIME MICHELE |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2617 | |

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on _26 June 2006_.

2a)☒ This action is **FINAL**.  2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) _1-17_ is/are pending in the application.

    4a) Of the above claim(s) _6, 12 and 15_ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-5, 7-11, 13, 14, 16 and 17_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All  b)☐ Some * c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## *Response to Amendment*

## *Response to Arguments*

1.      Applicant's arguments filed June 26, 2006 have been fully considered but they are not persuasive.

Applicant basically argues that Noda discloses that certain information is exchanged between an IC card before the wireless link may be established and not after the link is established.  In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., information exchanged after a link is established) are not recited in the rejected claim(s).  Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.  See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues that Noda does not disclose anything relating to the wireless communication unit (20), which is alleged to correspond to the claimed "wireless communication apparatus."  Examiner asserts that the action clearly stated on page 4 lines 5-6 that the IC card reads on the claimed "communication apparatus," and not as being argued by Applicant.

Applicant further argues that Noda fails to disclose a registration step and a reading step.  Examiner respectfully disagrees, because Noda clearly shows and discloses that when the user places the IC card in proximity to the IC-card contactless communication unit of the personal computer, the IC-card contactless communication unit detects the IC card, and the IC-card contactless communication unit **records** the

local-network information required for the personal computer to form a wireless link with

the personal computer in the IC card.  When the user places the IC card in proximity to

the IC-card contactless communication unit of the personal computer, the IC-card

contactless communication unit detects the IC card, and determines whether local-

network information is recorded in the IC card. If it is determined that local-network

information is recorded in the IC card, the IC-card contactless communication unit

**reads** the local-network information recorded in the IC card (see Office Action; pages 4-

5).

In view of the above, the rejections using Noda are maintained as refeated below.

These rejections are made **FINAL**.


### Information Disclosure Statement

2.    The information disclosure statement (IDS) submitted on June 26, 2006 and

have been considered by the Examiner and made of record in the application file.

3.    The information disclosure statement filed July 20, 2006 fails to comply with the

provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the Examiner cannot

interpret the document's relevance with an English translation.  It has been placed in the

application file, but the information referred to therein has not been considered as to the

merits.  Applicant is advised that the date of any re-submission of any item of

information contained in this information disclosure statement or the submission of any

missing element(s) will be the date of submission for purposes of determining

compliance with the requirements based on the time of filing the statement, including all

certification requirements for statements under 37 CFR 1.97(e).  See MPEP

§ 609.05(a).

## *Claim Rejections - 35 USC § 102*

4.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.      **Claims 1-4, 7-10, 13, 16 and 17** are rejected under 35 U.S.C. 102(e) as being

anticipated by **Noda (Pub # U.S. 2005/0015467 A1)**.

Consider **claims 1, 7 and 16**, Noda clearly shows and discloses

communication apparatus and method that allow setting for forming a wireless

link.  A personal computer **1**, reading on the claimed "second communication

apparatus," includes a CPU (central processing unit) **11**, which is connected to

an input/output interface **15** via a bus **14**, and furthermore, a ROM (read only

memory) **12** and a RAM (random access memory) **13** are connected to the bus.

An IC-card contactless communication unit **19** for detecting an IC card **2**, reading

on the claimed "wireless communication apparatus having a wireless

communication unit and a memory," when it is placed in close proximity thereto

and reading data from and writing data to the IC card, a wireless communication

unit **20** for forming a wireless link and exchanging data with, for example, the

access-point device **3**, by a wireless communication function conforming to IEEE

802.11b, according to access-point information, local-network information, or the

like that is set by the CPU, (abstract, paragraphs 52-53). The personal computer

**1-1**, reading on the claimed "second apparatus," starts processing when a user

performs an operation for requesting that local-network information required for

the personal computer **1-2**, reading on the claimed "first apparatus," to form a

wireless link with the personal computer be recorded in the IC card. When the

user places the IC card in proximity to the IC-card contactless communication

unit **19-1** of the personal computer, the IC-card contactless communication unit

detects the IC card, and the IC-card contactless communication unit records the

local-network information required for the personal computer **1-2** to form a

wireless link with the personal computer **1-1** in the IC card, reading on the

claimed "registration step," (paragraphs 78 and 80). When the user places the IC

card in proximity to the IC-card contactless communication unit **19-2** of the

personal computer **1-2**, the IC-card contactless communication unit detects the

IC card, and determines whether local-network information is recorded in the IC

card. If it is determined that local-network information is recorded in the IC card,

the IC-card contactless communication unit reads the local-network information

recorded in the IC card, reading on the claimed "reading step." The CPU **11-2**

sets network configuration of the wireless communication unit **20-2** according to

the local-network information read by the IC-card contactless communication

unit, reading on the claimed "setting step." Thus, a wireless LAN is formed

between the personal computer **1-1** and the personal computer **1-2** in ad-hoc

mode, reading on the claimed "communication method for allowing a first

apparatus to perform wireless communication by connecting said first apparatus

to a wireless communication apparatus having a wireless communication unit

and memory, said communication method comprising:

a registration step registering, when said wireless communication

apparatus is connected to a second apparatus, setting information for said first

apparatus in said memory of said wireless communication apparatus by said

second apparatus;

a reading step of reading, when said wireless communication apparatus

where the setting information has been registered at said registration step is

connected to said first apparatus, the setting information from said memory of

said wireless communication apparatus by said first apparatus; and

a communication step of performing wireless communication by said

wireless communication unit in accordance with the setting information set in said

setting step, whereby the wireless communication by said first apparatus is

achieved," (paragraphs 84 and 85).

Consider **claims 2 and 8**, and **as applied to claims 1 and 7**, respectively,

Noda further discloses that the predetermined wireless communication standard

carried out by a first communication apparatus is IEEE 802.11b, reading on the

claimed "the setting information includes information relating to a wireless LAN,"

(paragraphs 10 and 11).

Consider **claims 3 and 9**, and **as applied to claims 2 and 8**, respectively,

Noda further discloses that the personal computer requires an SSID and a WEP

KEY defined in IEEE 802.11b to be set before forming a wireless link with the

access-point device, reading on the claimed "the setting information includes any

of Service Set ID and Wireless Equivalent Privacy Key relating to wireless LAN

communication," (abstract, paragraph 50).

Consider **claims 4 and 10**, and **as applied to claims 1 and 7**,

respectively, Noda further discloses that the setting information may include at

least one of ID information, a password associated with the ID information, a user

name, and a password associated with the user name, reading on the claimed

"the setting information includes identification information of said first apparatus,"

(paragraph 15).

Consider **claims 13 and 17**, Noda clearly shows and discloses

communication apparatus and method that allow setting for forming a wireless

link. A personal computer, reading on the claimed "second communication

apparatus," includes a CPU (central processing unit), which is connected to an

input/output interface via a bus, and furthermore, a ROM (read only memory) and

a RAM (random access memory) are connected to the bus. An IC-card

contactless communication unit for detecting an IC card, reading on the claimed

"communication apparatus," when it is placed in close proximity thereto and

reading data from and writing data to the IC card, a wireless communication unit

for forming a wireless link and exchanging data with, for example, the access-

point device, reading on the claimed "first communication apparatus," by a

wireless communication function conforming to IEEE 802.11b, according to

access-point information, local-network information, or the like that is set by the

CPU, (abstract, paragraphs 52-53). A first communication apparatus that

includes wireless communication means for carrying out wireless communication

with another electronic apparatus based on a predetermined wireless

communication standard and reading means for reading the setting information,

by contactless communication, from an information recording medium detected

by a detection means. Since the access-point device is capable of writing data to

the IC card, it is possible to additionally record user information for forming a link

with a wireless LAN that is formed via the access-point device, (fig. 1,

paragraphs 10 and 69). When the user places the IC card in proximity to the IC-

card contactless communication unit **19-2** of the personal computer **1-2**, the IC-

card contactless communication unit detects the IC card, and determines

whether local-network information is recorded in the IC card. If it is determined

that local-network information is recorded in the IC card, the IC-card contactless

communication unit reads the local-network information recorded in the IC card.

The CPU **11-2** sets network configuration of the wireless communication unit **20-

2** according to the local-network information read by the IC-card contactless

communication unit. Thus, a wireless LAN is formed between the personal

computer **1-1** and the personal computer **1-2** in ad-hoc mode, reading on the

claimed "detection means for detecting a connection with said wireless

communication apparatus;

reading means for reading setting information for said first apparatus

registered in a memory of said communication apparatus by a second apparatus

in accordance with the result of detection by said detection; and

setting means for setting the setting information read by said reading

means in a wireless communication unit of said wireless communication

apparatus as wireless communication parameters;

wherein said wireless communication apparatus performs wireless

communication based on the setting information set in said wireless

communication unit, whereby the wireless communication by said first apparatus

is achieved," (paragraphs 84 and 85).

### Claim Rejections - 35 USC § 103

6.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.     The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

    1.    Determining the scope and contents of the prior art.
    2.    Ascertaining the differences between the prior art and the claims at issue.
    3.    Resolving the level of ordinary skill in the pertinent art.
    4.    Considering objective evidence present in the application indicating obviousness or nonobviousness.

8.     **Claims 5, 11 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable

over **Noda (Pub # U.S. 2005/0015467 A1)**, in view of **Sato (Pub # U.S. 2003/0009541**

**A1)**.

              Consider **claims 5 and 11**, and as applied to **claims 1 and 10**,

respectively, Noda clearly shows and discloses the claimed invention except that

the setting information on the IC card is compared to information already stored

on the second personal computer or access point.

              In the same field of endeavor, Sato clearly shows and discloses a network

system that comprises a target device to be managed that is connected to a

network, and a management device that manages the target device, reading on

the claimed "first and second communication devices," wherein the management

device enables the target device to establish communications over the network

and includes a first integrated circuit (IC) card drive in which an IC card stores

communication parameters for enabling the management device to manage the

target device, and wherein the target device includes a second IC card drive for

reading the communication parameters stored in the IC card to set the

communication parameters that have been read. The network system uses the

IC card as a relay to perform an initial setting of the communication parameters

on the target device. This enables the communication parameters to be set only

by insertion of the IC card into the target device, achieving a relatively easy

setting operation, reading on the claimed "communication method and apparatus

for connecting a communication apparatus to a first apparatus and performing

communication, comprising: a registration step of connecting said communication

apparatus to a second apparatus, and registering setting information for said first

apparatus in said communication apparatus via said second apparatus,"

(paragraph 10). When a user of the management device **10** withdraws an IC

card **50** from the IC card driver **20** of the management device, and carries and

inserts the IC card into the IC card driver **70** of the network apparatus **60**, the

controller **61** reads and sets some of the communication parameters stored in the

IC card corresponding to the pertinent network apparatus. More specifically, the

controller sets the communication parameters obtained through the IC card drive

and the interface **66** on the storage part **65**. The controller is required to identify

the communication parameters on the pertinent network apparatus among those

stored in the IC card. For example, if user ID and password pairs are stored in

the IC card, the controller may invite a user of the network apparatus to enter

his/her user ID/password pair, and set the identified communication parameters,

reading on the claimed "comparison step of comparing the identification

information registered at said registration step with identification information of

said first apparatus previously set in said first apparatus, wherein said first

apparatus controls performing the wireless communication in said

communication step in accordance with the result of comparison at said

comparison step," (paragraphs 71-75).

Therefore, it would have been obvious to a person of ordinary skill in the

art at the time the invention was made to incorporate a step of verifying user ID

and password as taught by Sato, in the system of Noda, in order to form a

wireless link between two apparatuses in a wireless system.

Consider **claim 14**, and **as applied to claim 13 above**, Noda further

discloses a first communication apparatus that includes wireless communication

means for carrying out wireless communication with another electronic apparatus

based on a predetermined wireless communication standard, reading means for

reading the setting information, by contactless communication, from an

information recording medium detected by a detection means, and setting means

for adjusting setting of the wireless communication means according to the

setting information read by the reading means, reading on the claimed "reading

means reads the setting information," (fig. 1, paragraphs 10 and 69).

However, Noda fails to disclose that the setting information on the IC card

is compared to information already stored on the second personal computer or

access point.

In the same field of endeavor, Sato clearly shows and discloses a network

system that comprises a target device to be managed that is connected to a

network, and a management device that manages the target device, reading on

the claimed "first and second communication devices," wherein the management

device enables the target device to establish communications over the network

and includes a first integrated circuit (IC) card drive in which an IC card stores

communication parameters for enabling the management device to manage the

target device, and wherein the target device includes a second IC card drive for

reading the communication parameters stored in the IC card to set the

communication parameters that have been read. The network system uses the

IC card as a relay to perform an initial setting of the communication parameters

on the target device. This enables the communication parameters to be set only

by insertion of the IC card into the target device, achieving a relatively easy

setting operation, reading on the claimed "communication method and apparatus

for connecting a communication apparatus to a first apparatus and performing

communication, comprising: a registration step of connecting said communication

apparatus to a second apparatus, and registering setting information for said first

apparatus in said communication apparatus via said second apparatus,"

(paragraph 10). When a user of the management device withdraws an IC card

from the IC card driver of the management device, and carries and inserts the IC

card into the IC card driver of the network apparatus, the controller reads and

sets some of the communication parameters stored in the IC card corresponding

to the pertinent network apparatus. More specifically, the controller sets the

communication parameters obtained through the IC card drive and the interface

on the storage part. The controller is required to identify the communication

parameters on the pertinent network apparatus among those stored in the IC

card. For example, if user ID and password pairs are stored in the IC card, the

controller may invite a user of the network apparatus to enter his/her user

ID/password pair, and set the identified communication parameters, reading on

the claimed "second reading means for reading the identification information from

said wireless communication apparatus; and comparison step of comparing the

identification information registered at said registration step with identification

information of said first apparatus previously set in said first apparatus, wherein

at said establishment step, the communication is established in accordance with

the result of comparison at said comparison step," (paragraphs 71-75).

Therefore, it would have been obvious to a person of ordinary skill in the

art at the time the invention was made to incorporate a step of verifying user ID

and password as taught by Sato, in the system of Noda, in order to form a

wireless link between two apparatuses in a wireless system.

### Conclusion

9.     Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

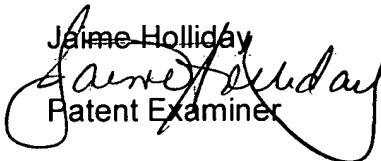than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jaime M. Holliday whose telephone number is (571)

272-8618. The examiner can normally be reached on Monday through Friday 7:30am

to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

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CHARLES APPIAH
PRIMARY EXAMINER

Jaime Holliday
Patent Examiner